



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/556,013	09/01/2006	Marilena Gusmeroli	163-667	3082
47888 7590 07/09/2010 HEDMAN & COSTIGAN, P.C. 1230 AVENUE OF THE AMERICAS 7th floor NEW YORK, NY 10020				
EXAMINER SULLIVAN, DANIELLE D				
ART UNIT		PAPER NUMBER		
1616				
MAIL DATE		DELIVERY MODE		
07/09/2010		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/556,013

Applicant(s)

GUSMEROLI, MARILENA

Examiner

DANIELLE SULLIVAN

Art Unit

1616

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 March 2010.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
4a) Of the above claim(s) 1-6 and 9-19 is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 7 and 8 is/are rejected.
7) ☒ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/22)
Paper No(s)/Mail Date 11/07/2005
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

Applicant's election with traverse of Group I, claims 7 and 8 and the copper salt, copper (II) methoxysuccinic acid in the reply filed on 3/1/2010 is acknowledged. The traversal is on the ground(s) that Groups I-IV have the same technical feature. This is not found persuasive because Strobel breaks unity of invention and the compounds can be made by different processes and used in different methods.

The requirement is still deemed proper and is therefore made FINAL.

Claims 1-6 and 9-19 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected Groups II-IV, there being no allowable generic or linking claim.

Claim Objections

Claims 7 and 8 objected to because of the following informalities: Formulas A1 through A7 should be rewritten so that all bonds are clearly legible. Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

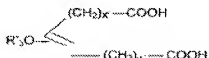
The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 7 and 8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 7 recites a formula (I): $A^* Cu$ where 'A represents the bibasic ion of an organic acid which can have the meanings (A1-A7)'. The fact that the claim recites the organic acid "can have the meanings" makes the claim vague because it implies there are other unstated definitions intended. Therefore the metes and bounds of the claim cannot be deciphered and render the claims indefinite.

Claim 8 recites the limitation "copper (II) salt of 2-methoxysuccinic acid" in claim 7. There is insufficient antecedent basis for this limitation in the claim because claim 7 has the following formula:

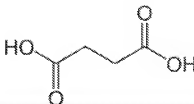
- (A⁴)₂:



wherein:

- R'₃ represents a C₁-C₃ alkyl group, linear or branched;
- x' is equal to 1 and y' is equal to 0;

. However,



succinic acid has the following formula:

Since the bonds in formula A⁴ are unclear the limitation of the copper (II) salt of 2-methoxysuccinic acid in claim 7 cannot be deciphered.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 7 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hopkins (4,552,677).

Applicant's Invention

Applicant claims copper (II) salt of methoxysuccinic acid.

Determination of the scope and the content of the prior art

(MPEP 2141.01)

Hopkins teaches copper salts of substituted succinic anhydride derivatives of formula (I) (column 2, line 55). The derivatives substituted group is selected from an alkoxy group (column 2, lines 1-7). The copper salts preferably of oxidative state +2 is preferred since it is the most stable (column 4, lines 58-68).

Ascertainment of the difference between the prior art and the claims

(MPEP 2141.02)

Hopkins does not disclose the specific compound copper (II) 2-methoxysuccinic acid where the substituted group is a methoxy. However, copper salts of substituted

succinic anhydride derivatives are taught to have substituted groups selected from an alkoxy group.

Finding of prima facie obviousness

Rationale and Motivation (MPEP 2142-2143)

It would have been obvious to one of ordinary skill in the art at the time of the invention to use the teachings of Hopkins and select a methoxy group to formulate copper (II) 2-methoxy succinic acid because Hopkins teaches that an alkoxy group may be selected when forming a copper (II) succinic acid derivative. One of ordinary skill in the art would have been able to formulate the specific species based on the teaching of an alkoxy substituted succinic acid derivative. In view of *In re Wood, Whittaker, Stirling, and Ohta*, 199 USPQ 137 (C.C.P.A. 1978), the addition of a substituent to a known compound is not enough to establish patentability since the claimed compounds would have been expected to have similar properties.

Furthermore, in view of *In re Henze*, 85 USPQ 261 (C.C.P.A. 1950), claims to a compound in homologous series are rejected where reference suggests a class of compounds; it does not matter that reference does not name all members of class since generic designation used is recognized by one of ordinary skill in the art. Therefore, formulating a methoxy substituted succinic acid derivative would have been prima facie obvious to one of ordinary skill in the art.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Danielle Sullivan whose telephone number is (571) 270-3285. The examiner can normally be reached on 7:30 AM - 5:00 PM Mon-Thur EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann Richter can be reached on (571) 272-0646. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Danielle Sullivan
Patent Examiner
Art Unit 1616

/Johann R. Richter/
Supervisory Patent Examiner, Art Unit 1616

Application/Control Number: 10/556,013
Art Unit: 1616

Page 7